



02 AUG 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Andrew D. Meikle
BIRCH, STEWART, KOLASH & BIRCH, LLP
P.O. Box 747
Falls Church, VA 22040-0747

In re Application of
Grue-Sorensen et al.
Application No.: 09/787,548
PCT No.: PCT/DK01/00069
Int. Filing Date: 31 January 2001
Priority Date: 31 January 2000
Attorney Docket No.: 3893-0112P
For: USE OF VITAMIN D-DERIVATIVES IN THE
TREATMENT OF OSTEOPOROSIS AND RELATED
BONE DISORDERS, AS WELL AS NOVEL VITAMIN
D3-DERIVATIVES

DECISION ON PETITION

UNDER 37 CFR 1.181

This decision is in response to applicants' "Letter In Response To Outstanding Office Action" filed 21 March 2002 which is being treated as a petition under 37 CFR 1.181 requesting that the Office action mailed 21 December 2001 be vacated and that the instant application file be corrected such it is based on international application PCT/DK01/00069.

BACKGROUND

On 31 January 2001, applicants filed international application PCT/DK01/00069 which claimed priority to an earlier United States application filed 31 January 2000.

On 20 March 2001, applicants filed a Transmittal Letter for entry into the national stage in the United States under 35 U.S.C. 371 accompanied by, *inter alia*, a check for \$1000.

On 07 May 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements Under 35 U.S.C. 371 In The United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge under 37 CFR 1.492(e) were required.

On 05 June 2001, the DO/EO/US mailed a Notification Of Acceptance Of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495 (Form PCT/DO/EO/903) indicating a date of completion of all 35 U.S.C. 371 requirements as 29 May 2001.

On 21 December 2001, the United States Patent and Trademark Office (PTO) issued a

first Office action on the merits.

On 21 March 2002, applicants filed the instant petition. The petition effectively requests that the Office action mailed 21 December 2001 be vacated because the content of the Office action clearly does not correspond to the subject matter or content of applicants' application.

On 24 June 2002, applicants submitted a copy of a PTO date-stamped receipt, a copy of a paper entitled "Filing Of Item(s) Late In PCT/USA National Case", a copy of a declaration of the inventors, and a statement indicating that the attached items are true copies of those originally submitted on 29 May 2001.

DISCUSSION

MPEP at section 503 states, in part:

"A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO."

Applicants' receipt lists a 2 page declaration and a check for \$1216 and includes a PTO date stamp of 29 May 2001.

PTO financial records indicate receipt of \$1216 on 29 May 2001. Additionally, the a file contents section of the file lists a "declaration 29 May 2001" even though one is not present in the file wrapper.

The evidence is sufficient to establish that the executed declaration and \$1216 were filed on 29 May 2001.

A thorough review of the file reveals that the US national stage application was constructed using the incorrect international application and that the Office action mailed 21 December 2001 was not based on applicants' invention as originally filed as international application PCT/DK01/00069.

CONCLUSION

In view of the above, applicants' petition is GRANTED.

The Office action mailed 21 December 2001 is hereby **vacated**.

The application is being returned to the DO/EO/US for correction of the file contents, specifically for insertion of the PCT Article 20 papers corresponding to international application PCT/DK01/00069 into the instant application.

The application will then be forwarded to the appropriate Technology Center for examination on the merits.



Michael A. Neas
PCT Special Program Examiner
Office of PCT Legal Administration



Richard Cole
PCT Legal Examiner
Office of PCT Legal Administration

Telephone: (703) 308-0954

Facsimile: (703) 308-6459